

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN TOMKO
and JEFFREY E. TELSCHOW

Appeal No. 1997-3374
Application 08/386,393

ON BRIEF

Before WILLIAM F. SMITH, Administrative Patent Judge, and MCKELVEY, Senior Administrative Patent Judge, and SPIEGEL, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

I.

Upon consideration of APPELLANTS' BRIEF (Paper No. 10), the EXAMINER'S ANSWER (Paper No. 12), APPELLANTS' REPLY BRIEF (Paper No. 13), and the SUPPLEMENTAL EXAMINER'S ANSWER (Paper No. 14), it is

ORDERED that the examiner's rejection of claims 1 and 4 as being unpatentable under 35 U.S.C. § 103 over Grey, U.S. Patent 5,310,808 (1994), is reversed.

This decision is controlled by In re Jones, 958 F.2d 347, 349-51, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992).

Appellants' claims are directed to compounds that contain a neopentylene phosphonate moiety, in particular, neopentylene 1-phenylvinylphosphonate. The claimed phosphonate is not prima facie obvious over Grey's vinyl phosphonates, even though the claimed phosphonate is a member of the genus of vinyl phosphonates broadly disclosed in Grey for the following reasons: (1) Grey describes a large genus of alkylene phosphonate containing-phenylvinyl compounds (the group B in the formula at column 3, lines 14-27, can be a branched or linear alkylene group of unlimited length);¹ (2) Grey discloses ethylene and propylene 1-phenylvinyl phosphonates (column 3, lines 32-33), but does not explicitly describe neopentylene phosphonates. (3) The claimed neopentylene phosphonate is not sufficiently similar in structure to Grey's propylene phosphonate to render it prima facie obvious. Neopentylene, $-\text{CH}_2-\text{C}(\text{CH}_3)_2-\text{CH}_2-$, has a carbon atom substituted with four carbon-containing moieties in the linking group; while propylene, $-\text{CH}(\text{CH}_3)-\text{CH}_2-$, has a carbon atom substituted with two carbon-containing

¹ The examiner erroneously states that "B may be up to 60 carbons." Answer, page 4, lines 14-15. It is the R and R' groups of the formula depicted at column 3, lines 3-8 which may each be C_1-C_{30} .

moieties in the linking group. We find that Grey does not provide any reason, suggestion, or motivation to make the claimed neopentylene phosphonate. Accordingly, the rejection must be reversed.

II.

Upon consideration of APPELLANTS' BRIEF (Paper No. 10), the EXAMINER'S ANSWER (Paper No. 12), APPELLANTS' REPLY BRIEF (Paper No. 13), and the SUPPLEMENTAL EXAMINER'S ANSWER (Paper No. 14), it is

ORDERED that the examiner's rejection of claims 1 and 4 as being unpatentable under 35 U.S.C. § 103 over the combination of Grey and Granzow, U.S. Patent 4,255,324 (1981), is reversed.

Granzow does not cure the deficiencies of Grey. Granzow does not provide any suggestion, reason or motivation to choose neopentylene as group B in Grey's vinyl phosphonate represented by the formula shown at column 3, lines 14-27, from the large genus of alkylene phosphonates encompassed by the formula. The examiner's rejection is based on impermissible hindsight. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its

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teacher.” In re Fine, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988),
citing W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303,
312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Accordingly, the rejection is
reversed.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Fred E. McKelvey)	
Senior Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Carol Spiegel)	
Administrative Patent Judge)	

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